Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

125525

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	09/802,163	March 8, 2001
on _____ Signature_____	First Named Inventor C. Keith	
Typed or printed name _____	Art Unit 3691	Examiner C.B. Graham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
    (Form PTO/SB/96)

☑ attorney or agent of record.   42,015
    Registration number _____ .

☐ attorney or agent acting under 37 CFR 1.34.

    Registration number if acting under 37 CFR 1.34 _____

/Kevan L. Morgan/
_____
Signature

Kevan L. Morgan
_____
Typed or printed name

206.695.1712
_____
Telephone number

December 9, 2011
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of __2__ forms are submitted.

Applicant: C. Keith   Attorney Docket No.: 125525

Application No.: 09/802163   Art Unit: 3691 / Confirmation No.: 1129

Filed: March 8, 2001   Examiner: C.B. Graham

Title: AUTOMATED FIRST LOOK AT MARKET EVENTS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

December 9, 2011

Applicant respectfully submits that clear error exists in the final Office Action mailed August 9, 2011. Moreover, the Advisory Action mailed November 9, 2011, did not address the errors that were raised in applicant's Response After Final. For at least the reasons discussed below, applicant requests withdrawal of the claim rejections and allowance of the application.

Claims 1-29, which are pending in the application, were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Serkin et al. in view of Anaya et al.[1] However, there is no combination of Serkin and Anaya that teaches or suggests all of Claims 1-29.

Claim 1 is directed to a method of facilitating trading at a market, and recites, in part:

> automatically receiving from the market, at the market participant's computer, notification of a new contra-side best market price that was provided to the market by another market participant for the trade, wherein the notification of the new contra-side best market price is received from the market in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at the market participant's computer.

The final Office Action conceded that Serkin fails to teach or suggest the above elements of Claim 1, and instead relied upon Anaya. The Office Action's reliance on Anaya is mistaken.

Anaya purports to provide alerts for market events. Processes for detecting or resolving various types of alert conditions are found in individual alert components 187-192 and

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[1] The final Office Action frequently mistakenly referred to "Kalmus." From the context of the Office Action, applicant believes the Examiner meant to refer to "Serkin" in such circumstances. Applicant is responding accordingly.

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coordinator components 199-201, as illustrated in Figure 11. These processes purport to use data such as quotes, trading prices, trading volumes, and/or the existence of special market conditions to detect and resolve alert conditions. The data for detecting and/or resolving alerts enters the market monitoring system 10 via incoming Nasdaq Quote Data Service (NQDS) messages received by line handlers 18, 18'. See, e.g., Col. 21, lines 43-51, of Anaya.

At Col. 21, lines 52-61 (as cited in the final Office Action), Anaya explains:

> To detect some types of alerts, the alert components 187-201 use published offers of market participants. The published offer prices at which the market participants will buy and/or sell specified securities are referred to as bid and ask quotes, respectively. The most aggressive quotes define the inside quotes. The inside ask quote is the lowest ask quote. The inside bid quote is the highest bid quote. Separate inside quotes are defined for each type of trading security. New quotes are received in incoming NQDS messages from the feed lines 12.

As noted, the alert components of Anaya use published offers of market participants. The published offer prices, referred to as bid and ask quotes, are published to all market participants at the same time via the NQDS. Whether a quote is a "new quote" or a "previous quote," it is still a quote that is published to all market participants. Anaya nowhere teaches or suggests "automatically receiving from the market . . . notification of a new contra-side best market price that was provided to the market by another market participant for the trade, wherein the notification of the new contra-side best market price is received from the market *in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at the market participant's computer*," as claimed in Claim 1. (Emphasis added.)

According to the present application, a market participant may get a "first look" at market data such as a new contra-side best market price provided by another market participant, before it is published to other market participants. To obtain this benefit, the market participant satisfies a market-related condition. The first look feature is an incentive to traders to satisfy the condition in order to receive advance notification of a new contra-side best market price.

The final Office Action further cited Anaya at Col. 23, lines 24-31, which states:

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Broker/dealers executing trades of Nasdaq or exchange-listed (CQS) issues must report trades to Nasdaq within 90 seconds. Nasdaq reports these trades to the public via NTDS messages. The line handlers 18, 18' receive incoming messages for trades from the feed lines 12. These incoming messages produce the QTC alerts detected by the market monitoring system 10 of FIG. 1.

Anaya's disclosure of reporting trades to Nasdaq does not teach or suggest "receiving from the market, at the market participant's computer, notification of a new contra-side best market price that was provided to the market by another market participant for the trade," nor does it suggest that the "notification of the new contra-side best market price is received from the market in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at the market participant's computer." To the contrary, Anaya relies on orders and quotes that are published to all market participants via Nasdaq's quote service.

To the extent that Anaya transmits an alert, such alerts do not constitute "notification of [a] new contra-side best market price . . . in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at the market participant's computer." The alerts merely raise issues regarding current quotes (that have already been published to the market participants) such as quotes causing a locked or crossed market condition (Col. 1, lines 38-40), an existing quote differing from a previous quote by more than a predetermined amount (Col. 1, lines 48-50, and Col. 2, lines 1-3), an existing quote differing by more than a predetermined amount and the item being a component of an option, future, or a market index (Col. 1, lines 57-60), a trade report being late (Col. 2, lines 9-11), a trade occurring during a trading halt (Col. 2, lines 16-18), and a difference between predicted trading data and data describing a portion of a trade being greater than a preselected amount (Col. 2, lines 26-28).

Nowhere does Anaya teach or suggest that notification of a new contra-side best market price is received from a market by a market participant in advance of other market participants as a result of the market participant satisfying a market-related condition. It should be noted that,

according to Claim 1, a market participant "is a *trading party*" that is "participating in the market with other market participants." In contrast to Anaya's disclosure where market participants using systems such as Nasdaq simultaneously receive published quotes, a market participant according to Claim 1 "receiv[es] from the market . . . notification of a new contra-side best market price that was provided to the market by another market participant . . . *in advance of the other market participants* as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at market participant's computer." (Emphasis added.) Applicant therefore submits that a *prima facie* basis for rejecting Claim 1 has not been established.

In addition, while the final Office Action (page 2) conceded that Serkin fails to disclose "receiving from the market, at the market participant's computer, notification of a new contra-side best market price that was provided to the market by another market participant for the trade, wherein the notification of the new contra-side best market price is received from the market in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at the market participant's computer," the final Office Action did not identify specific disclosure in Anaya that allegedly teaches these features of Claim 1.

Instead, the final Office Action (pages 2-3) merely quoted Anaya at Col. 21, lines 52-61, and alleged that "it would have been obvious . . . to modify the teachings of Kalmus [sic - Serkin] to include wherein the market participants can execute a trade for the security at the published price wherein the market." Unfortunately, it is <u>irrelevant</u> to the acknowledged deficiencies of Serkin whether "market participants can execute a trade for the security at the published price" as alleged in the final Office Action. For at least this additional reason, applicant submits that a *prima facie* basis for rejecting Claim 1 has not been established.

According to the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385, 1395-97 (2007), the key to supporting any rejection under 35 U.S.C. § 103

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is a clear articulation of the reason(s) why the claimed invention would have been obvious. See also M.P.E.P. § 2143. The question at hand is not simply one of interpretation. Neither the final Office Action nor the Advisory Action provided such articulation. Because Serkin and Anaya, in any combination, fail to disclose or suggest all of the elements of Claim 1, the rejection of Claim 1 must be withdrawn.

Independent Claims 4, 8, 13, 18, 28, and 29 contain similar elements and are patentable over the cited art for at least the same reasons as Claim 1. Claims 4, 8, 13, 18, 28, and 29, and their dependent claims, are also patentable for additional claimed subject matter. For instance, Serkin fails to teach or suggest the elements of "automatically . . . selecting a party to receive notification of a new contra-side best market price for a trade at the market in advance of other market participants" and "automatically . . . notifying the selected party of the new contra-side best market price for the trade in advance of notifying the other market participants," as claimed in Claim 4.

In view of the lack of specific disclosure that teaches or suggests what is claimed in Claims 1-29, a *prima facie* case of obviousness has not been established. Therefore, the claim rejections should be withdrawn and the claims allowed.

Respectfully submitted,

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